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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/121,152	10/19/1998	STEVEN SAY-KYOUN OW	20565-0111	2999

23579 7590 08/23/2006

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EXAMINER

KINNEY, ANNA L

ART UNIT PAPER NUMBER

1731

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/121,152

Applicant(s)

OW ET AL.

Examiner

Anna Kinney

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 09 August 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 21-28,30-38,40 and 42-50.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: The change to claim 28 now recites "a high consistency pulper". The limitations of claims 25 and 34 reciting "cellulases" have been removed and limitations reciting "hemicellulases" have been inserted. The limitations of claims 26 and 35 reciting "hemicellulases" and microorganisms from which cellulases are derived have been removed.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection against claim 48 under 35 USC 112, 1st paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' proposed amendment of dependent claims 25, 26, 28, 34, and 35 presents newly claimed emodiments not previously presented and requires further consideration and/or search at this time. The response received on 8/9/06 was considered. Rejection of claims 27 and 37 under 35 USC 112, 1st paragraph, is proper. The rejection of claims 21-27, 30, 45, and 47-50 under 35 USC 103(a) over JP '299 in view of Fuentes et al is proper. The rejection of claims 28, 31-38, 40, 42-44, and 46 under 35 USC 103(a) over JP '299 and Fuentes in view of Hageman et al is proper. The Examiner notes that claim 41 was cancelled, and that claim 47 depends from cancelled claim 41.

In response to remarks, the Examiner refers to the responses in the previous Office Action, and notes the following.

The request for a corrected filing date was forwarded to OIPE on 2/27/06.


Fuentes relates to both cellulases and hemicellulases. Cellulases, hemicellulases, and pectinases are all carbohydrases. Defiberization, or pulping, is recited as the first step of the methods of claims 21 and 31. Fuentes was applied to show a pulping step under pH conditions within the claimed pH conditions, using enzymes capable of dislodging ink particles.

Only dependent claims 27 and 37 recite the limitation "alkali is not added". The specification only provides for caustic soda (pg. 5, lines 9-11), not elimination of all alkali from the aqueous medium.

The declarations submitted appear to be previously submitted evidence. The declarations have been considered and responded to in the last Office Action. The declaration of Dr. Eveleigh that is accompanied by sampling results appears to attempt to address two issues: the conditions disclosed by reference JP '299, and allegedly surprising results of the claimed invention. The Examiner's response in the last Office Action addresses both issues. The Examiner's comment regarding the cellulase selected for the experiments were not directed to a difference between the cellulase disclosed in JP '299 and the cellulase of the experiments, but rather the cellulase used to represent the method of JP '299 in the experiments compared to the cellulase selected to represent the claimed invention in the experiments.

The enzyme activity range is relevant to claim 48.

JP '299 does not teach away from the claimed method. JP '299 does not criticize, discredit, or otherwise discourage the use of the claimed method steps (see MPEP 2145 X. D. 1.)


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